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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/582,216	07/20/2000	PETER FICKEISEN	193413USOPCT	2523
22850	7590	11/25/2005	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			SHOSHO, CALLIE E	
			ART UNIT	PAPER NUMBER
			1714	

DATE MAILED: 11/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/582,216	<b>Applicant(s)</b> FICKEISEN ET AL.	
	<b>Examiner</b> Callie E. Shosho	<b>Art Unit</b> 1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 9-14, 16-26, 28, 31, 32, 36-52, 54, 57 and 58 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-14, 16-26, 28, 31, 32, 36-52, 54, 57 and 58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. In the office action mailed 9/14/05, the examiner rejected present claims 9 and 22 on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over Fickeisen et al. (U.S. 6,409,860). Claims 10-14, 16-21, 23-26, and 28 were indicated as objected to as being dependent upon a rejected base claim but allowable if rewritten in independent form while claims 31-32, 36-52, and 54 were indicated as allowed.

In the after-final response filed 11/8/05, applicants amended claim 9 by inserting the limitation of claim 12 into claim 9 and subsequently canceling claim 12.

However, despite the narrowing of the scope of the claims, it is evident to the examiner that in fact all present claims can be properly rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over Fickeisen et al. Given that original claim 12, for instance, could also have been rejected under obviousness type double patenting (but was not), examiner regrets not placing such a rejection of record previously.

Given that applicants' after-final amendment filed 11/8/05 was based on examiner's position that claim 12 was allowable if rewritten in independent form and in order to give applicants opportunity to respond to the new grounds of rejection set forth below, the after-final amendment has not been entered and the finality of the office action mailed 9/14/05 has been withdrawn. Thus, the following action is non-final.

### **Double Patenting**

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or

improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 9-14, 16-26, 28, 31-32, 36-52, 54, and 57-58 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-2, 4, and 6-7 of U.S. Patent No. U.S. 6,409,860 (Fickeisen et al.). Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following explanation.

Fickeisen et al. disclose method of adhering a floor covering to a floor with a floor adhesive comprising aqueous composition comprising water, 20-99% polymer obtained from 60-100% C<sub>1</sub>-C<sub>20</sub> alkyl (meth)acrylate and 0-40% additional monomer such as C<sub>1</sub>-C<sub>10</sub> hydroxyalkyl (meth)acrylate, (meth)acrylamide, ethylenically unsaturated carboxylic acid, and dicarboxylic acid or anhydride thereof, and 1-80% or 40-80% filler. The polymer possesses glass transition temperature (T<sub>g</sub>) < -25 °C. The polymer is in the form of a 45-75% aqueous emulsion. It is further disclosed that the composition is free of organic solvent.

The difference between Fickeisen et al. and the present claimed invention is (a) Fickeisen et al. is silent with respect to the gel content and number average molecular weight (M<sub>n</sub>) of the polymer and specific type of filler, (b) amounts of filler, polymer, and monomer used to obtain polymer as well as values of M<sub>n</sub>, T<sub>g</sub>, and gel content, (c) Fickeisen et al. is silent with respect to additives, and (d) Fickeisen et al. is silent with respect to specific types of floor coverings and substrates.

With respect to difference (a), applicants' attention is drawn to MPEP 804 where it is disclosed that "the specification can always be used as a dictionary to learn the meaning of a term in a patent claim." *In re Boylan*, 392 F.2d 1017, 157 USPQ 370 (CCPA 1968). Further, those portions of the specification which provide support for the patent claims may also be examined and considered when addressing the issue of whether a claim in an application defines an obvious variation of an invention claimed in the patent. (underlining added by examiner for emphasis) *In re Vogel*, 422 F.2d 438, 164 USPQ 619,622 (CCPA 1970).

Consistent with the above underlined portion of the MPEP citation, attention is drawn to col.2, lines 33-34 and 40-43 of Fickeisen et al. which discloses that the polymer possesses gel

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content of 0-90% and  $M_n > 10,000$  and to col.3, lines 30-35 of Fickeisen et al. which discloses that the filler is chalk possessing average diameter of 2-50  $\mu\text{m}$ , quartz possessing average particle diameter of 3-50  $\mu\text{m}$ , or mixtures thereof.

With respect to difference (b), as is seen in the following table, Fickeisen et al. disclose amount of filler, amount of polymer, Tg,  $M_n$ , and amount of monomers that overlap those presently claimed while the gel content of the polymer encompasses that presently claimed.

	Present Claims	Fickeisen et al.
Amount Filler	50-90%, 55-90%, or 60-85%	1-80% or 40-80%
Amount Polymer	10-50% or 10 to 45%	20-99%
Tg polymer	-50 to 20 $^{\circ}\text{C}$ or -35 to 20 $^{\circ}\text{C}$ or -30 to 0 $^{\circ}\text{C}$ or -28 to -5 $^{\circ}\text{C}$ or	< -25 $^{\circ}\text{C}$
$M_n$ polymer	<30,000	>10,000
Gel content polymer	5-40% or 5-20%	0-90%
Amount C1-C20 alkyl (meth)acrylate	60-100% or 80-100% or 90-99.8%	60-100%
Amount other monomer	0-40% or 0-20% or 0.2-10%	0-40%

It would have been within the skill level of, as well as obvious to, one of ordinary skill in the art to choose values of Tg, Mn, and gel content for the polymer, including those presently claimed, in Fickeisen et al. in order to control the properties of the polymer including temperature at which polymer forms film, viscosity of the polymer, and tackiness, respectively. Further, it would have been within the skill level of, as well as obvious to, one of ordinary skill in the art to choose amounts of polymer and filler, including those presently claimed, in order to control the viscosity, adhesion, cost, etc. of the composition. Additionally, it would have been within the skill level of, as well as obvious to, one of ordinary skill in the art to choose amounts of monomer, including those presently claimed, in order to control the properties of the polymer.

In light of the above and in light of the overlap between the claimed composition and the composition disclosed by Fickeisen et al., it is urged that it would have been within the bounds of routine experimentation, as well as the skill level of one of ordinary skill in the art, to use composition which is both disclosed by Fickeisen et al. and encompassed within the scope of the present claims, and thereby arrive at the claimed invention from Fickeisen et al.

With respect to difference (c), it is noted that Fickeisen et al. is silent with respect to the use of additives.

However, applicants' attention is drawn to MPEP 804 where it is disclosed that "the specification can always be used as a dictionary to learn the meaning of a term in a patent claim." *In re Boylan*, 392 F.2d 1017, 157 USPQ 370 (CCPA 1968). Further, those portions of the specification which provide support for the patent claims may also be examined and considered when addressing the issue of whether a claim in an application defines an obvious variation of an

invention claimed in the patent. (underlining added by examiner for emphasis) *In re Vogel*, 422 F.2d 438,164 USPQ 619,622 (CCPA 1970).

Consistent with the above underlined portion of the MPEP citation, attention is drawn to col.3, lines 36-40 of Fickeisen et al. which disclose the use of additives such as wetting agent, dispersant, defoamer, and preservative.

In light of the above, it therefore would have been obvious to one of ordinary skill in the art to use additive such as wetting agent, dispersant, defoamer, and preservative in the coating of Fickeisen et al. in order to produce coating with desired properties, i.e. possesses desired surface tension, contains no antimicrobial materials or foam, etc., and thereby arrive at the claimed invention from Fickeisen et al.

With respect to difference (d), it is noted that while Fickeisen et al. broadly disclose adhering a floor covering to a floor, i.e. substrate, Fickeisen et al. is silent with respect to specific types of floor coverings and substrates.

However, applicants' attention is drawn to MPEP 804 where it is disclosed that "the specification can always be used as a dictionary to learn the meaning of a term in a patent claim." *In re Boylan*, 392 F.2d 1017, 157 USPQ 370 (CCPA 1968). Further, those portions of the specification which provide support for the patent claims may also be examined and considered when addressing the issue of whether a claim in an application defines an obvious variation of an invention claimed in the patent. (underlining added by examiner for emphasis) *In re Vogel*, 422 F.2d 438,164 USPQ 619,622 (CCPA 1970).

Consistent with the above underlined portion of the MPEP citation, attention is drawn to col.3, lines 61-65 of Fickeisen et al. that discloses that specific floor coverings include PVC,



foam covering with textile backing, polyester nonwoven, etc. and to col.4, lines 2-3 that discloses that the floor covering is adhered to various floors or substrates including wood, stone, concrete, tile, etc.

In light of the above, it therefore would have been obvious to one of ordinary skill in the art to use specific floor covering on specific floor or substrate depending on end use, and thereby arrive at the claimed invention from Fickeisen et al.

4. Claims 9-14, 16-26, 28, 31-32, 36-52, 54, and 57-58 are directed to an invention not patentably distinct from claims 1-2, 4, and 6-7 of commonly assigned U.S. 6,409,860.

Specifically, although the conflicting claims are not identical they are not patentably distinct for the reasons set forth in paragraph 3 above.

5. The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302).

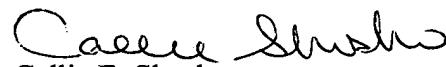
Commonly assigned U.S. 6,409,860, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 571-272-1123. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Callie E. Shosho  
Primary Examiner  
Art Unit 1714